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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,190	10/16/2001	Engelbert van Pelt	US 018170	5403

7590 12/17/2004

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EXAMINER

QUINONES, ISMAEL C

ART UNIT PAPER NUMBER

2686

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,190

Applicant(s)

VAN PELT ET AL.

Examiner

Ismael Quiñones

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on July 28, 2004.

Claims 1, 4-5, 7-10 are pending in the present application. **This Action is made FINAL.**

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claim 1** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation for generating a third audio signal in a second operational mode introduces new matter. The specification and drawings of the instant application fail to disclose either implicitly or explicitly the generation of a third audio signal. Applicant is welcomed to point out where in the specification or the drawings the Examiner can find support for the above said limitation if Applicant believes otherwise.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1, 4-5, 7-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wingate (U.S. Pat. No. 6,006,115).

Regarding **claim 1**, Wingate discloses a headset for connecting to an electronic audio device, said headset having a first unit comprising: a first sound transducer for reproducing audible sounds (speakers; *Figs. 1 & 2, item 104*); a first interface for receiving a first input signal (Receiving radio transmissions from a home stereo unit; *col.*

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4, lines 9-14); and a first processor for processing the first input signal to generate a first audio signal in a first operational mode of the first unit (*Fig. 3, item 301*), said first processor supplying said first audio signal to said first sound transducer in said first operational mode (A signal processor for transmitting necessary signals for activating or disabling an operational mode, wherein the device can be provided with a switch for enabling the device to operate in one operational mode; *col. 4, line 64 thru col. 5, line 25*); wherein said headset further has a second unit connectable to said first unit (*Figs. 1 & 2, items 104, 203, and 102*), said second unit comprising: a second interface for receiving a second input signal in a second operational mode (Receiving an incoming call alert; *col. 4, lines 21-26*), different from the first operational mode of the headset a second sound transducer for reproducing audible sounds (The incoming call alert for operating the headset for answering or making phone calls; *col. 4, line 55 thru col. 5, line 4*); generating a second audio signal and a third audio signal in said second operational mode (Generating an audio signal for listening to the other party through the speakers, and another audio signal for responding to the other party through a microphone; *col. 4, lines 55-63*), supplying said second audio signal to said first unit for application to said first sound transducer (Supplying the audio signals to the speakers when either making a phone call or receiving a call; *col. 4, line 21 thru col. 5, line 25*), and for supplying said third audio signal to said second sound transducer (An audio signal generated by responding to the other party through the speakers; *col. 4, line 21 thru col. 5, line 25*).

Wingate fails to clearly specify a second processor for processing the second input signal.

Nonetheless the addition of a second processor for splitting the functionalities of a single processor does not render patentability or novelty because the functionalities or outcome for alternating different operational modes and supplying audio signals is not modified or different from that carried by a single processor. (*See Duplan v. Deering Milliken, Inc*, 197 USPQ 342).

Regarding **claim 4**, and as applied to claim 1, Wingate disclose the aforementioned headset. In addition the feature of a power source shared by the first and second unit in the second operational mode is inherent to Wingate (wireless headset; *Figs. 1 & 2*).

Regarding **claim 5**, and as applied to claim 1, Wingate disclose the aforementioned headset wherein at the least the first unit or the second unit has memory (A voice system for recognizing voice commands programmed in said system; *col. 5, lines 5-20*); and the first and second units functionally share the memory in the second operational mode (Speaking commands through a microphone for initiating a call by dialing an indicated party number; *col. 5, lines 15-20*).

Regarding **claim 7**, and as applied to claim 1, Wingate disclose the aforementioned headset wherein at the least the first unit or the second unit has a user interface for enabling a user to control at least the first or the second audio signal (Speakers; *Figs. 1 & 2, item 104*); the first and second units functionally share the user interface in the second operational mode (Listening to the other party through the speakers when making a phone call or receiving a call; *col. 4, line 21 thru col. 5, line 25*).

Regarding **claims 8 and 10**, and as applied to claim 1, Wingate disclose the aforementioned headset wherein the first unit functions in one two operational mode both

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an earpiece for a mobile phone and/or an earpiece one channel of stereo audio (A wireless headphone receiving radio frequency transmissions from a sound system to provide music and other audio programming such as incoming calls or call initialization; *col. 2, line 27 thru col. 3, line 45*).

Regarding **claim 9**, and as applied to claim 8, Wingate disclose the aforementioned wherein said first unit further comprises a transceiver for wirelessly communicating with the mobile phone (*Figs. 1 & 2, item 202*).

Response to Arguments

8. Applicant's arguments with respect to **claims 1, 4, 5, 7-10** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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10. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Crystal Park II

2021 Crystal Drive

Arlington, VA 22202

Sixth Floor (Receptionist)

11. Any inquiry concerning this communication on earlier communications from the Examiner should be directed to Ismael Quiñones whose telephone number is (703) 305-8997. The Examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

12. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379, and fax number is (703) 746-9818. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 305-4700


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or call customer service at (703) 306-0377.

Ismael Quiñones

I.Q.

December 13, 2004


RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
12/13/04